APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/965,562	09/25/2001	Bryson Gordon	NAI1P140/01.131.01	3082

28875	7590	02/24/2005	EXAMINER	
			POLTORAK, PIOTR	

Zilka-Kotab, PC
P.O. BOX 721120
SAN JOSE, CA 95172-1120

ART UNIT	PAPER NUMBER
2134	

DATE MAILED: 02/24/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

PTO-90C (Rev. 10/03)

		Application No.	Applicant(s)
Office Action Summary		09/965,562	GORDON ET AL.
		Examiner	**Art Unit**	
		Peter Poltorak	2134	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) FROM
THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed
  after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
  Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any
  earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on <u>25 September 2001</u>.

2a)☐ This action is **FINAL**.   2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is
closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) <u>1-41</u> is/are pending in the application.

    4a) Of the above claim(s) <u>14-18, 31-33 and 35-37</u> is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) <u>1-13, 19-30, 34 and 38-41</u> is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All   b)☐ Some * c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage
application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)

2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.

4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ .

5) ☐ Notice of Informal Patent Application (PTO-152)

6) ☐ Other: _____.

DETAILED ACTION

Election/Restrictions

1. This application contains claims directed to the following patentably distinct species of the claimed invention:

> i. A method for certifying e-mail messages free from viruses:
>
> 1-13, 19-30
>
> ii. A method for certifying instant messages free from viruses:
>
> 35-37
>
> iii. A method for certifying hosted site content free from viruses:
>
> 14-18 and 31-33

2. Claims 34, 38-41 are generic.

3. Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable.

    Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

    Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as

provided by 37 CFR 1.141. If claims are added after the election, applicant

must indicate which are readable upon the elected species. MPEP §09.02(a).

Should applicant traverse on the ground that the species are not

patentably distinct, applicant should submit evidence or identify such

evidence now of record showing the species to be obvious variants or clearly

admit on the record that this is the case. In either instance, if the examiner

finds one of the inventions unpatentable over the prior art, the evidence or

admission may be used in a rejection under 35 U.S.C. 103(a) of the other

invention.

4. A telephone call was made to Kevin Zilka *(408-971-2573)* on 2/8/05 to

request an oral election to the above restriction requirement. Group I *(claims

1-13 and 19-30)* has been elected with traverse.

5. Claims 1-13 and 19-30, 34 and 38-41 have been examined.

Claim Rejections - 35 USC § 101

6. Claims 19-30 are rejected under 35 U.S.C. 101 because the claimed

invention is directed to non-statutory subject matter.

Claims 19-30 are product claims implementing computer readable medium.

The application suggests that the computer readable medium can be a carrier

wave (e.g. claim 28). A carrier wave is non-tangible and as a result the

claims are considered to be directed towards abstract ideas and are not

statutory.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly
> claiming the subject matter which the applicant regards as his invention.

7. Claims 1, 5, 7, 27, 34 and 38 are rejected under 35 U.S.C. 112, second
   paragraph, as being indefinite for failing to particularly point out and distinctly
   claim the subject matter that applicant regards as the invention.

8. The term: "it" in claims 1, 27 and 34 is not understood. The term is treated as
   "the e-mail".

9. The term "when" in claims 5 and 38 is not understood. It is not clear whether
   "automatically scanning the e-mail <u>when</u> a user sends the e-mail" limits the e-
   mail scanning being automatically triggered at the time when user sends (e.g.
   press a send button) e-mail or it simply refers to the fact that e-mail sent by
   the user is automatically scanned. In other words it is not clear whether the
   scanning must be almost instantaneous upon user indicating e-mail to be sent
   or whether the limitation allows for a short delay e.g. e-mail is sent to the
   server which automatically handles e-mail scanning.

10. The term "describing" in claim 7 is not understood.

11. Claims 2-4, 6, 8-13 and 38-41 are rejected by virtue of their dependence.

Appropriate correction is required.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35

U.S.C. 102 that form the basis for the rejections under this section made in this

Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

12. Claims 1, 6-7, 19-20, 27, 34 and 39 are rejected under 35 U.S.C. 102(b) as

anticipated by *AVG (AVG anti-virus)* as evidenced by *Suffolk-L*

(http://archiver.rootsweb.com/th/read/SUFFOLK/1999-05/0927040114),

Microscopy (Microscopy ListServer Archives,

http://www.msa.microscopy.com/cgi-

bin/ReadPrintEmailHTML.pl?filename=9905.txt, 2nd e-mail) and Listserv

(http://listserv.uark.edu/scripts/wa.exe?A2=ind9912c&L=sag-

l&F=&S=&P=2411, 2nd e-mail).

13. As per claim 1 *AVG* provides a certificate added to e-mail sent from a

computer to a recipient *(e.g. in Suffolk-L, the e-mail from A.G. Forman)*, the

certificate identifying the e-mail as being scanned for viruses and certifying

that no viruses were found *(the bottom of e-mails: "Outgoing mail is certified*

Virus Free". Checked by AVG..." etc.).

14. Claims 19, 27 and 37 are substantially equivalent to claim 1; therefore claims

19, 27 and 37 are similarly rejected.

15. As per claim 7, as best understood, *AVG* discloses a web link

(http://www.grisoft.com).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for

all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

16. Claims 2-3, 5, 21-24, 28-29 and 38 are rejected under 35 U.S.C. 103(a) as being unpatentable over AVG (AVG anti-virus) as evidenced by *Suffolk-L (http://archiver.rootsweb.com/th/read/SUFFOLK/1999-05/0927040114), Microscopy (Microscopy ListServer Archives, http://www.msa.microscopy.com/cgi-bin/ReadPrintEmailHTML.pl?filename=9905.txt, 2nd e-mail) and Listserv (http://listserv.uark.edu/scripts/wa.exe?A2=ind9912c&L=sag-l&F=&S=&P=2411, 2nd e-mail)* in view of *Official Notice.*

17. *AVG* teaches an e-mail certificate as discussed above.

18. As per claim 2 *AVG* does not explicitly teach the e-mail being created using a desktop mail application.

    Official Notice is taken that it is old and well-known practice to create an e-mail using a desktop mail application, (e.g. Outlook). One of ordinary skill in the art at the time of applicant's invention would be motivated to employ a desktop mail application to take advantage of desktop mail application's usability.

19. As per claims 3 and 21-22 *AVG* does not explicitly teach that the sending and receiving computers are desktop computers or handheld computers.

However, the choice of using a desktop or handheld computers to send or

receive e-mail would have been obvious to one of ordinary skill in the art

given that it is well known and barring any unexpected results to the contrary.

20. As per claim 23 *AVG* does not explicitly teach that the computers sending and

receiving e-mail are servers located within a computer network. Official

Notice is taken that it is old and well-known practice to utilize servers to send

and receive e-mail *(e.g. Microsoft Exchange, on line e-mail servers etc.)*. One

of ordinary skill in the art at the time of applicant's invention would be

motivated to employ servers to send and receive e-mail to take advantage of

multiple benefits of client server environment in e-mail environment, for

example allowing sender and receiver to communicate while they travel.

The limitation: "sending and receiving servers being located within a computer

network" is implicit. E-mail is exchanged between entities within a network

(e.g. Internet entities).

21. As per claim 24 *AVG* does not teach certificates that contain only graphical

images.

Official Notice is taken that it is old and well-known practice to use certificates

containing only graphical images (e.g. Security Metrics Certified, BBBOnline,

SSL locks etc.). One of ordinary skill in the art would have been motivated to

perform such a modification in order to simplify the identification of the

certificate and prevent altering of the certificate.

22. As per claim 28 *AVG* does not explicitly teach that the computer codes

(implementing the invention) are stored on a medium selected from the group

consisting of CD-ROM, floppy disk, tape, flash memory, system memory or a

hard drive.

Official Notice is taken that it is old and well-known practice to use CD-ROM,

floppy disk, tape, flash memory, system memory or a hard drive as a medium

giving the benefit of inexpensive and proven/reliable technology.

23. As per claim 29 *AVG* does not explicitly teach cleaning infecting data.

Official Notice is taken that it is old and well-known practice to clean infecting

data. One of ordinary skill in art at the time of applicant's invention would be

motivated to clean infected data to prevent computer problems.

24. Claims 4 and 11-13 are rejected under 35 U.S.C. 103(a) as being

unpatentable over AVG (AVG anti-virus) as evidenced by *Suffolk-L*

(http://archiver.rootsweb.com/th/read/SUFFOLK/1999-05/0927040114),

Microscopy (Microscopy ListServer Archives,

http://www.msa.microscopy.com/cgi-

bin/ReadPrintEmailHTML.pl?filename=9905.txt, 2nd e-mail) and Listserv

(http://listserv.uark.edu/scripts/wa.exe?A2=ind9912c&L=sag-

I&F=&S=&P=2411, 2nd e-mail) in view of Chen et al. (U.S. Patent No.

5832208).

25. *AVG* teaches e-mail certified as being free of viruses as discussed above.

26. As per claim 4 *AVG* does not explicitly teach scanning attachments contained

within the e-mail.

Chen et al. teach scanning e-mail attachments *(Chen et al., Abstract)*. It

would have been obvious to one of ordinary skill in the art at the time of

applicant's invention to incorporate scanning e-mail attachments. One of

ordinary skill in the art would have been motivated to perform such a

modification in order to avoid computer problems *(Chen et al., col. 1 lines 39-*

52).

27. As per claim 11 *Chen et al.* teach the computer being a network server *(col. 4*

lines 13-30). It would have been obvious to one of ordinary skill in the art at

the time of applicant's invention to use a network server as taught by *Chen et*

al. One of ordinary skill in the art would have been motivated to perform such

a modification in order to avoid the necessity of installing anti-virus software

on all workstations.

As per claim 12 and 13 scanning e-mail for viruses and attaching certificate at

the server would be implicit.

28. Claims 5 and 38 are rejected under 35 U.S.C. 103(a) as being unpatentable

over AVG (AVG anti-virus) as evidenced by *Suffolk-L*

(http://archiver.rootsweb.com/th/read/SUFFOLK/1999-05/0927040114),

Microscopy (Microscopy ListServer Archives,

http://www.msa.microscopy.com/cgi-

bin/ReadPrintEmailHTML.pl?filename=9905.txt, 2nd e-mail) and Listserv

(http://listserv.uark.edu/scripts/wa.exe?A2=ind9912c&L=sag-

I&F=&S=&P=2411, 2nd e-mail) in view of *ACS (ACS Microcomputer*

Workshop, "Message management in Outlook for Windows", 1999)

29. *AVG* teaches scanning and sending e-mail as discussed above. *AVG* does

not explicitly teach the e-mail being scanned automatically when user sends

the e-mail.

ACS teaches automatic scanning *(default spell check option)* when e-mail is

sent *(Spell Checking a message)*.

It would have been obvious to one of ordinary skill in the art at the time of

applicant's invention to scan e-mail automatically when user sends the e-mail

as taught by *ACS*. One of ordinary skill in the art would have been motivated

to perform such a modification in order to take advantage of a main

computing strong points: tasks automation.

30. Claims 8-10, 26, 30 and 40-41 are rejected under 35 U.S.C. 103(a) as being

unpatentable over AVG (AVG anti-virus) as evidenced by *Suffolk-L*

(http://archiver.rootsweb.com/th/read/SUFFOLK/1999-05/0927040114),

Microscopy (Microscopy ListServer Archives,

(http://www.msa.microscopy.com/cgi-

bin/ReadPrintEmailHTML.pl?filename=9905.txt, 2nd e-mail) and Listserv

(http://listserv.uark.edu/scripts/wa.exe?A2=ind9912c&L=sag-

l&F=&S=&P=2411, 2nd e-mail) in view of *Fisher (U.S. Patent No. 5311591)*.

31. *AVG* teaches attaching a certificate if no viruses are found as discussed

above.

AVG does not teach attaching a digital signature and does not teach that the

recipient verifies that the e-mail has not been tampered with.

Fisher teaches attaching a digital signature and teaches a content recipient

verifying that no tampering occurred *(Fisher, col. 16 lines 9-23).* It would

have been obvious to one of ordinary skill in the art at the time of applicant's

invention to attach a digital signature and verify that content has not been

tampered with. One of ordinary skill in the art would have been motivated to

perform such a modification in order to verify that no virus infection occurred

(Fisher, col. 16 lines 9-23).

32. Claim 25 is rejected under 35 U.S.C. 103(a) as being unpatentable over AVG

(AVG anti-virus) as evidenced by *Suffolk-L*

(http://archiver.rootsweb.com/th/read/SUFFOLK/1999-05/0927040114),

Microscopy (Microscopy ListServer Archives,

http://www.msa.microscopy.com/cgi-

bin/ReadPrintEmailHTML.pl?filename=9905.txt, 2nd e-mail) and Listserv

(http://listserv.uark.edu/scripts/wa.exe?A2=ind9912c&L=sag-

I&F=&S=&P=2411, 2nd e-mail) in view of *Feghhi et al. (Jalal Feghhi, Jalil*

Feghhi and Peter Williams "Digital Certificates, Applied Internet Security",

1998, ISBN: 0201309807).

33. *AVG* teaches certificate as discussed above. *AVG* does not teach certificate

containing graphics and text.

Feghhi et al. teach a certificate containing graphics and text *(Feghhi et al., pg.*

151 Fig. 5-21). It would have been obvious to one of ordinary skill in the art at

the time of applicant's invention to utilize the certificate containing graphics

and text as taught by *Feghhi et al.* One of ordinary skill in the art would have

been motivated to perform such a modification in order to clearly identify the

certificate and provide additional information pertaining the certificate while

limiting space used *(text takes less space than graphics)*.
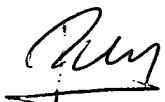

Conclusion

The prior art made of record and not relied upon is considered pertinent to

applicant's disclosure: *Spear (U.S. Patent No. 6611925)*.
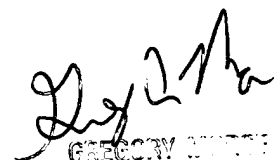

Any inquiry concerning this communication or earlier communications from

the examiner should be directed to Peter Poltorak whose telephone number is

(571)272-3840. The examiner can normally be reached Monday through

Thursday from 9:00 a.m. to 4:00 p.m. and alternate Fridays from 9:00 a.m. to

3:30 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the

examiner's supervisor, Gregory Morse can be reached on (571) 272-3838. The

fax phone number for the organization where this application or proceeding is

assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the

Patent Application Information Retrieval (PAIR) system. Status information for

published applications may be obtained from either Private PAIR or Public PAIR.

Status information for unpublished applications is available through Private PAIR

only. For more information about the PAIR system, see http://pair-

direct.uspto.gov. Should you have questions on access to the Private PAIR

system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-

free).

Signature

2/17/05

Date